

**REMARKS/ARGUMENTS**

Applicant notes that the Art Unit currently specified by the Office Action cover page is 2614 but was specified in the previous Office Action of Feb. 16, 2006 as 2645. Applicant respectfully requests confirmation of the Art Unit as 2614.

Claims 1 through 20 are pending in the application.

Claims 1, 2, 7-12, 14 and 16 are rejected under 35 U.S.C. § 102(e) as being anticipated by U.S. Patent No. 6,704,571 (issued Mar. 9, 2004) to Moon [hereinafter "*Moon*"].

Claims 3-5 and 17-19 are rejected under 35 U.S.C. § 103(a) as being unpatentable over *Moon* in view of U.S. Patent No. 6,456,858 (issued Sep. 24, 2002) to Streter, of record, [hereinafter "*Streter*"].

Claim 6 is rejected under 35 U.S.C. § 103(a) as being unpatentable over *Moon* combined with *Streter* in further view of U.S. Patent Application Publication No. 2001/0014604, App. No. 09/063,028 (published Aug. 16, 2001) by Kingdon et al. [hereinafter "*Kingdon*"].

Claims 13, 15 and 20 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The instant claims are directed to a mobile wireless communication station, and methods therefor, wherein the mobile station is transitioning between *data rate modes*. See generally, Applicant's Published Specification, U.S. Patent Application Publication No. 2003/0040331, page 1, ¶ 0009 (published Feb. 27, 2003) [hereinafter "*Spec.*"]. An objective of the claimed

mobile station and methods therefor, is “avoiding transmission of assistance or any type of data when a multi-mode device is in a slow data rate mode, for example analog mode.” See Spec., page 2, ¶ 0010. Thus, “[i]n one embodiment of the invention, data is transmitted from a communication network to a mobile wireless communication station before the mobile wireless communication station switches from a fast data rate mode, such as digital mode, to a slow data rate mode, such as analog mode.” See Spec., page 2, ¶ 0019. Therefore, a mobile station being connected to a first base station or first network having a first data rate mode, requests data from the first base station or first network, not data parameter changes, prior to switching to a second data rate mode.

In contrast to the above, the *Moon* disclosure is concerned with reducing or eliminating data loss, or packet loss, during handoffs.” See *Moon*, col. 2, lines 5-16; col. 4, lines 27-30; Abstract. Thus, Moon discloses a method of “modifying transmission parameters, such as a window size and code book . . . to limit the amount of data that can be lost during a handoff.” See *Moon*, col. 2, lines 5-16. “[W]indow size specifies the number of frames or packets to send before receiving an acknowledgment, and a code book provides a method for sending long strings of data using shorthand symbols.” See *Moon*, col. 3, lines 47-50.

Thus in accordance with *Moon*, “[t]o reduce data loss during handoffs, mobile unit 20, MSC 12, or other appropriate elements of system 10 modify transmission parameters, such as window sizes and code books, prior to handoffs.” See *Moon*, col. 4, lines 27-30.

While *Moon* discusses that data throughput may be hindered by its disclosed method of window size and code book reduction, “after handoff, [a] mobile unit 20 may renegotiate for a larger window size and code book to resume a high level of data throughput.” See *Moon*, col. 4,

lines 45-50. Therefore, the *Moon* disclosure concerns handoffs between base stations having the same or similar data rate modes in order to be able to resume high level data throughput.

Further therefore, *Moon* has no disclosure of transitioning between first and second data rate modes, or of requesting data prior to transitioning.

#### Claim 1

The Examiner has argued that *Moon* discloses “operating in a first data rate mode and a second data rate mode” in accordance with Applicant’s claim 1. See USPTO Office Action, page 2, ¶ 2 (date mailed Aug. 8, 2006) [hereinafter “Aug. 8<sup>th</sup> OA”].

Applicant respectfully disagrees. *Moon* has no such disclosure as was discussed above. Applicant agrees with the Examiner to the extent that *Moon* Fig. 4, step 60 and step 84 are a first and second wireless link, respectively, that may be for data communication in accordance with the *Moon* disclosure at col. 3, lines 42-44. However, *Moon* does not discuss data rate modes, or whether the first and second wireless links have different data rate modes.

While *Moon* in FIG. 4, step 74 shows determining a signal strength threshold, and negotiating a reduced window size and code book at col. 8, lines 20-28, if the signal is below the threshold, there is no discussion of transitions between a first and second data rate mode.

Further in *Moon*, the requested reduced window size and code book is used by the mobile station to communicate with both the first and second base stations, that is, between both of the base stations the mobile station is handing off between. See *Moon*, FIG. 1, items 18, and item 20; col. 2, lines 64-66. In contrast, Applicant’s claim 1 provides the feature of predicting the data rate change and requesting data from the network prior to the transition.

Therefore, Applicant's claim 1 is patentably distinguishable from *Moon*, and Applicant respectfully requests reconsideration and withdrawal of Examiner's 35 U.S.C. § 102(e) claim 1 rejection.

#### Claim 2

Claim 2 depends from, and includes all limitations of, independent claim 1. Therefore, claim 2 is patentably distinguishable from *Moon* for the reasons provided above with respect to claim 1. Applicant respectfully requests reconsideration and withdrawal of Examiner's 35 U.S.C. § 102(e) claim 2 rejection.

#### Claim 7

As discussed above with respect to claim 1, *Moon* does not disclose "predicting when the mobile wireless communication station transitions between the first data rate mode and the second data rate mode," and does not disclose "transmitting data before the mobile wireless communication station transitions between the first data rate mode and the second data rate mode."

Therefore, Applicant respectfully disagrees with Examiner that *Moon* discloses the features of Applicant's independent claim 7. See Aug. 8<sup>th</sup> OA, page 3. Specifically, *Moon* does not disclose a "processor for predicting when the mobile wireless communication station transitions between the first data rate mode and the second data rate mode," and does not disclose a "transmitter for transmitting data before the mobile wireless communication station transitions between the first data rate mode and the second data rate mode."

Therefore, Applicant's claim 7 is patentably distinguishable from *Moon* for the reasons provided above with respect to claim 7. Reconsideration and withdrawal of Examiner's 35 U.S.C. § 102(e) rejection of claim 7 is respectfully requested.

Claims 8 through 10

Because claims 8 through 12 and 14 are dependent claims that depend from, and include all limitations of, independent claim 7, claims 8 through 12 and 14 are likewise patentably distinguishable from *Moon*. Reconsideration and withdrawal of Examiner's 35 U.S.C. § 102(e) rejection of claims 8 through 12 and 14 is respectfully requested.

Claim 16

As discussed above with respect to claim 1, *Moon* does not disclose the features of Applicant's claims pertaining to a first data rate mode and a second data rate mode. Therefore claim 16 is patentably distinguishable for the same reasons provided above for claims 1 and 7. Reconsideration and withdrawal of Examiner's 35 U.S.C. § 102(e) rejection of claim 16 is respectfully requested.

Claims 3-5 and 17-19

Claims 3 through 5 depend from, and include all limitations of independent claim 1, and claims 17 through 19 depend from and includes all limitations of independent claim 16. As discussed above with respect to claims 1, 7 and 16, *Moon* does not disclose the features of claim 1, 7 or claim 16 and therefore cannot be used to establish a prima facie case under 35 U.S.C. § 103(a) for any dependent claims that include the same limitations.

*Streter* also does not disclose the claim 1 or claim 16 limitations, and therefore Applicant's dependent claims 3-5 and 17-19 are patentably distinguishable from *Moon* and *Streter* individually and in combination. Therefore, reconsideration and withdrawal of Examiner's 35 U.S.C. § 103(a) rejection of claims 3-5 and 17-19 is respectfully requested.

#### Claim 6

Claim 6 is a dependent claim and includes all limitations of independent claim 1. Therefore, as discussed above, *Moon* and *Streter* do not establish a prima facie case under 35 U.S.C. § 103(a) for claim 6. While *Kingdon* may disclose requesting ephemeris data, *Kingdon* does not, independently or in combination with *Moon* and *Streter*, disclose the features of claim 6 required to establish a prima facie case under 35 U.S.C. § 103(a). Therefore, reconsideration and withdrawal of Examiner's 35 U.S.C. § 103(a) rejection of claim 6 is respectfully requested.

#### Claims 13, 15 and 20

The Examiner has noted that claims 13, 15 and 20 are directed toward allowable subject matter. See Aug. 8<sup>th</sup> OA, page 9. Because Applicant has argued above with respect to the allowability of the base and intervening claims, Applicant respectfully requests reconsideration and withdrawal of the objections regarding the dependent form.

## CONCLUSION

No amendment made was related to the statutory requirements of patentability unless expressly stated herein. Also, no amendment made was for the purpose of narrowing the scope of any claim, unless Applicant(s) has/have argued herein that such amendment was made to distinguish over a particular reference or combination of references.

The Commissioner is hereby authorized to deduct any additional fees arising as a result of this response, including any fees for Extensions of Time, or any other communication from or to credit any overpayments to Deposit Account No. 50-2117.

It is submitted that the claims clearly define the invention, are supported by the specification and drawings, and are in a condition for allowance. Applicant respectfully requests that a timely Notice of Allowance be issued in this case. Should the Examiner have any questions or concerns that may expedite prosecution of the present application, the Examiner is encouraged to telephone the undersigned.

Respectfully submitted,  
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